



UNITED STATES DEPARTMENT OF COMMERCE
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JUL 22 1986

In re Application of:

William J. Christoff et al)
Serial Number : 06/529,256) ORDER
Filed : September 6, 1983) TO
Title : ROCKET ENGINE AS) SHOW CAUSE
 UNDERWATER ACOUSTIC)
 GENERATOR)

1. This is an Order to Show Cause why the invention disclosed in U.S. Patent application Serial No. 06/529,256 should not be held abandoned under 35 U.S.C. 182.
2. William J. Christoff and James A. Nestlerode are the applicants of U.S. Patent application Serial No. 06/529,256 entitled "Rocket Engine As Underwater Acoustic Generator" filed September 6, 1983 in the U.S. Patent and Trademark Office (hereinafter the USPTO) by their appointed attorneys and/or agents Frederick Hamann, Reg. No. 17,771, Philip Schneider, Reg. No. 17,991, and Harry B. Field, Reg. No. 27,880 of Rockwell International Corporation and/or Rocketdyne Division. The applicants, their appointed attorneys and/or agents, and Rockwell International Corporation and/or Rocketdyne Division, to the extent the applicants have assigned the subject invention to Rockwell International Corporation and/or Rocketdyne Division, are hereinafter referred to as the Principals.
3. On February 14, 1984, the USPTO placed the subject matter in the above identified application under a Secrecy Order pursuant to 35 U.S.C. 181 by mailing copies of the Order (attachment 1) and Permit A (attachment 2) to the Principals.
4. On February 22, 1984 Philip Schneider, on February 23, 1984 William J. Christoff, and on February 27, 1984 James A. Nestlerode signed Secrecy Order receipts (attachments 3, 4, and 5 respectively) acknowledging receipt of the Secrecy Order and Permit A issued on the subject matter disclosed in the application.

5. The first paragraph on page 2 of the Secrecy Order states:

Any other application already filed or hereafter filed which contains any significant part of the subject matter of this application falls within the scope of this order. Such other application and the common subject matter should be brought to the attention of the Security Group, Licensing and Review, Patent and Trademark Office, if the other application is not under secrecy order.

6. Subparagraph (d) of 37 CFR 5.2 states:

The secrecy order is directed to the subject matter of the application. Where any other application in which a secrecy order has not been issued discloses a significant part of the subject matter of the application under secrecy order, the other application and the common subject matter should be called to the attention of the Patent and Trademark Office.

7. The provisions of 37 CFR 5.33 require:

All correspondence in connection with this part [Part 5 of Title 37 of the Code of Federal Regulations governing inventions under Secrecy Orders], including petitions, should be addressed to "Commissioner of Patents and Trademarks (Attention Licensing and Review), Washington, D.C. 20231."

8. On April 13, 1984, Principals properly filed U.S. Patent application Serial No. 06/623,282, which is described as a continuation-in-part (and contains a significant part of the subject matter) of application Serial No. 06/529,256, directly in Licensing and Review of the USPTO. The applicants and appointed attorneys and/or agents in Serial Nos. 06/529,256 and 06/623,282 are the same.
9. On or about April 27, 1984 application Serial No. 06/529,256 went abandoned.
10. On March 4, 1985 Harry B. Field signed a receipt (attachment 6) acknowledging receipt of an extension of the subject Secrecy Order through February 14, 1986.

11. On February 13, 1986, the USPTO mailed a Renewal of the subject Secrecy Order (attachment 7) to Principals extending the order through February 14, 1987.
12. On March 3, 1986, Principals filed U.S. Patent application Serial No. 06/835,665 which is described as a continuation-in-part of application Serial No. 06/623,282 which as noted above is a continuation-in-part of Serial No. 06/529,256. William J. Christoff, James A. Nestlerode and James G. Johanson are the applicants of Serial No. 06/835,665. Lawrence N. Ginsberg, Reg. No. 30,943, Harry B. Field, Reg. No. 27,880 and H. Fredrick Hamann, Reg. No. 17,771 are the appointed attorneys and/or agents of Serial No. 06/835,665. Application Serial No. 06/835,665 contains a significant part of the subject matter of Serial No. 06/529,256. Serial No. 06/835,665 was filed through the regular mailroom section rather than the Licensing and Review section of the USPTO. It did not include any reference to the then and still existing Secrecy Order of the parent application. Further, Principals have not at any time brought the common subject matter to the attention of Licensing and Review.
13. The purpose of a Secrecy Order issued pursuant to 35 U.S.C. 181 is to prevent further publication or disclosure of an invention, the publication or disclosure of which has been determined to be detrimental to the national security of the United States.
14. Because of the above facts, the Principals are ordered to show cause why the invention of U.S. Patent application 06/529,256 significantly repeated in both Serial Nos. 06/623,282 and 06/835,665 should not be held abandoned under 35 U.S.C. 182. More specifically, the Principals are required to show (1) why, after issuance and knowledge of a Secrecy Order, they are not in violation of the Secrecy Order, Statute and regulations by the unprotected filing of "continuation-in-part" application Serial No. 06/835,665 or (2) why the Commissioner should exercise his discretion under Section 182 to excuse any violation(s). Such showing must include, in verified form (i.e. under oath or declaration - 37 CFR 1.68), an explanation or information as to the following:
 - A. In view of the express language of the Secrecy Order and quoted regulations, what steps if any, were taken to ensure that there would be no improper disclosure of material within the scope of the Secrecy Order. If no such steps were taken, why were they not taken?

- B. Why was application Serial No. 06/835,665 submitted to the USPTO through unprotected channels and without reference to the Secrecy Order in the parent case contrary to regulations?
- C. Why was the Licensing and Review section of the USPTO not expressly notified of application Serial No. 06/835,665 contrary to language in the Secrecy Order and regulations?
- D. What steps, if any, were taken to determine whether disclosure of the subject matter as repeated in application Serial No. 06/835,665 to the attorney or agent who is not of record in Serial No. 06/529,256, but is of record in Serial No. 06/835,665 (i.e., Lawrence N. Ginsberg), was permissible under the existing Secrecy Order. If no such steps were taken, why were they not taken?

15. The Principals are hereby given sixty (60) days to respond to this show cause order. Failure to respond will result in abandonment of the invention disclosed in Serial No. 06/529,256, and substantially repeated in Serial Nos. 06/623,282 and 06/835,665, under 35 U.S.C. 182.

Original signed by
Donald W. Peterson

Donald J. Quigg
Assistant Secretary and Commissioner
of Patents and Trademarks

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Prepared by KLCage/jhm/6/20/86

bcc: Commissioner's File
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